

Remarks/Arguments

In the Office Action, the Examiner required applicant under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner states that the application contains claims directed to the following patentably distinct species: a) whole blood, b) platelets, c) plasma, and d) blood stem cells. The Examiner argues that the species are independent or distinct because whole blood and the cells and plasma of the blood have well-known distinct properties.

The Examiner further states that currently there is no generic claim or claim X is generic. Applicants respectfully submit that Claim 41 is a generic claim linking all elected and non-elected species. Claim 41 is directed to a method for ex-vivo treatment of a blood product, comprising treating a blood product with carbon monoxide. In Claim 42, a blood product is defined as at least one of whole blood and a blood component.

Pursuant to MPEP 809.04, “[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim.” Thus, restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). That is, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141 (MPEP 809.02(a)).

Furthermore, the burden is on the Examiner to examine the generic claim throughout its scope, together with any claims dependent thereon drawn to non-elected species or inventions, rather than for Applicants to limit the scope of the generic claim to conform to the scope of any species listed in the Restriction Requirement.

It is pointed out that the species named by the Restriction Requirement are not necessarily mutually exclusive. Pursuant to MPEP 806.04(f): “Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive...to require restriction between claims limited to species, the claims must not overlap in scope.” Therefore, the species election is improper. As a result, electing one

“species” does not necessarily allow the Examiner to omit searching claims directed to other “species”, since those claims still read on the elected species.

Finally, the non-elected species are closely related to the elected species, platelets. The claims of the “species” all pertain to a method for ex-vivo treatment of a blood product, comprising treating a blood product with carbon monoxide. The generic term “blood product” as set forth in claims 41-54 encompasses whole blood and components selected from the group consisting of platelets, plasma, and blood stem cells. Applicants submit there is no undue search burden on the Examiner to perform a search to cover claims directed to all the related species, whole blood, platelets, plasma, and blood stem cells, as they are all blood products that share common features. A simultaneous search of these species can be made without additional search burden, since searching species “platelets” would necessarily entail searching the subject matter of the remaining species.

Thus, it is not an undue burden to examine all of the species in the application. Pursuant to MPEP 803, “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” Thus, no serious search burden will result if the Restriction Requirement is withdrawn.

Nevertheless, in the event the Examiner maintains the Species Restriction, Applicants provisionally elect, with traverse, the species platelets. Presently claims 41-47 and 50-54 read on the elected species.

For the reasons stated above, Applicants respectfully request reconsideration and withdrawal of the species Restriction Requirement.

This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. Applicants reserve the right to timely file and prosecute one or more divisional patent applications covering the subject matter of the non-elected claims and claim priority from the parent application.

In the event that the Examiner is of the opinion that further discussion of the application would be helpful, the Examiner is hereby respectfully requested to telephone the applicants’ undersigned representative.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of the Requirement for Restriction. An early action on the merits of the Claims is courteously solicited.

Respectfully submitted,

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Date



Mark M. Friedman
Attorney for Applicants
Registration No. 33,883
Dr. Mark Friedman LTD.
Moshe Aviv Towers, 54th Floor
7 Jabotinsky Street
Ramat Gan 52520
Israel
Telephone: 972-3-611-4100
Facsimile: 972-3-611-4101
Email: patents@friedpat.com